

REMARKS

Applicants have carefully reviewed the Final Office Action mailed on October 16, 2006. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. With this amendment, claim 53 is amended. No new matter is added. Claims 1-4, 6-8, 10, 13-14, 18-20, 25, 27, 53, 55, 58-59, and 76-87 remain pending.

Inventorship and Corrected Filing Receipt

A request to correct inventorship under 37 C.F.R. §1.48(c) was filed on December 17, 2004. With that filing, Applicants additionally requested the issuance of a corrected filing receipt reflecting the change of inventorship. Applicants have not yet received an indication that the inventorship has been corrected, and have not yet received a corrected filing receipt reflecting the change of inventorship. Applicants respectfully request that these be issued in due course.

IDS and Formal Drawings

Applicants have not received an initialed and dated copy of the Form 1449 that had been filed with the Information Disclosure Statement on April 16, 2006. Applicants respectfully request that the Examiner return an initialed and dated copy of this Form PTO-1449 with the next communication from the Office. Furthermore, there is no indication of whether or not the formal drawings filed on July 25, 2003 are accepted. Applicants respectfully request that the Examiner indicate whether or not the drawings are accepted in the next communication from the Office.

Claim Rejections under 35 U.S.C §102

Claims 1-4, 6-8, 10, 14, 19-20, 25-27, 53, 55, and 58-59 are rejected under 35 U.S.C. §102(b) as being anticipated by Jacobsen et al. in U.S. Patent No. 6,579,246. Initially, please note that U.S. Patent No. 6,579,246 does not appear to qualify as prior art under 35 U.S.C. §102(b) because the date of the patent is less than one year prior to Applicants' filing date. Applicants recognize that Jacobsen et al. was previously published more than one year prior to Applicants' filing date. However, the publication did not publish more than year prior to

Applicants' priority date. In light of these comments, Applicants recognize that Jacobsen et al. (and/or the prior publication thereof) *may or may not* qualify as prior art under one or more sections of 35 U.S.C. §102 – but not under 35 U.S.C. §102(b). Accordingly, the current rejection is improper and should be withdrawn.

Applicants previously indicated that because the claims recite, for example, a coil formed from a wire having a substantially non-circular cross section distinguishes the claimed invention from the cited art because Jacobsen et al. only appears to teach a coil formed from a wire having a circular cross-section. In the “Response to Arguments” section, the Examiner indicated that the term “substantially”, as recited in the claims, “appears to render the claims indefinite”. Because of this, the Examiner indicated that Jacobsen et al. anticipates the claimed invention. We respectfully disagree.

It should be first noted that claims 1-4, 6-8, 10, 14, 19-20, 25-27, 53, 55, and 58-59 are not rejected under 35 U.S.C. §112. Therefore, it is assumed that the Examiner has determined that the claims are definite.

Additionally, the MPEP indicates that some relative terms (e.g., substantially) have been held to be definite. See: MPEP §2173.05(b). In particular, in the Andrew Corp. v. Gabriel Electronics case, the Federal Circuit court held that the term substantially was definite because one of ordinary skill in the art would know what was meant by it. Andrew Corp. v. Gabriel Electronics, 847 F.2d 819 (Fed. Cir. 1988). The MPEP does not provide an example case law citation that held to the contrary (i.e., that “substantially” is indefinite). In this case, Applicants respectfully submit that one of ordinary skill in the art would understand what was meant by a wire with substantially non-circular cross section and, consequently, the relative term “substantially” as recited in the claims is definite.

Furthermore, the Examiner indicated that the specification does not provide a standard for ascertaining the requisite degree. Applicants respectfully disagree. Paragraphs [0066]-[0068], for example, describe some example coils that are formed from a wire having a non-circular cross section. For example, paragraph [0068], ll 12-16 indicate that “coil 200 may be made so that, when wound, it has a substantially non-circular cross section 405, which may have at least one substantially flat side, for example, side 406”. Thus, not only would one of ordinary skill in the art understand the claim language, the specification provides general

guidelines sufficient to establish that the language is sufficiently definite. See also: MPEP §2173.05(b) citing In re Nehrenberg, 200 F.2d 161 (CCPA 1960).

Turning now to the art rejection, (assuming *arguendo* that Jacobsen is prior art) independent claims 1, 7, and 25 recite a coil that is formed from a wire having a substantially non-circular cross section. Independent claim 53, which is amended to correct a minor typographical error, similarly recites coil made of a wire having a substantially non-circular cross section. Jacobsen et al. does not appear to teach or suggest these limitations. Instead, Jacobsen et al. only teaches coils formed from round wires. Based on this distinction, Applicants respectfully submit that independent claims 1, 7, 25, and 53, as well as those claims depending therefrom are patentable over Jacobsen.

Claim Rejections under 35 U.S.C §103

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatented over Jacobsen et al. in view of Lui (US Publication No. 2002/0010475). As indicated above, claim 7 is believed to be patentable over Jacobsen et al. because Jacobsen et al. does not teach or suggest all the claim limitations. Lui does not cure this deficiency. Accordingly, Applicants respectfully submit that claim 7 is patentable over the combination of Jacobsen et al. and Lui. Because claim 13 depends from allowable claim 7, it is patentable for the same reasons and because it adds significant elements to distinguish it further from the art.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatented over Jacobsen et al. in view of Levine et al. (US Publication No. 2003/0009157). As indicated above, claim 7 is believed to be patentable over Jacobsen et al. because Jacobsen et al. does not teach or suggest all the claim limitations. Levine et al. does not cure this deficiency. Accordingly, Applicants respectfully submit that claim 7 is patentable over the combination of Jacobsen et al. and Levine et al.. Because claim 18 depends from allowable claim 7, it is patentable for the same reasons and because it adds significant elements to distinguish it further from the art.

Claims 76-87 are rejected under 35 U.S.C. 103(a) as being unpatented over Jacobsen et al. in view of Tsuji et al. (US Patent No. 5,181,668). For the reasons set forth above,

Applicants respectfully submit that independent claims 1, 7, 25, and 53 are patentable over Jacobsen et al. Tsuji et al. teaches an apparatus for running a wire through a pipe. Nowhere in the Tsuji et al. reference is a medical device contemplated. Consequently, this reference must be considered non-analogous art and, therefore, it cannot be properly combined with Jacobsen et al. Simply put, one of ordinary skill in a medical device art would not turn to "apparatuses for running a wire through a pipe" art for inspiration.

Furthermore, in order for the teachings of Tsuji et al. to be properly used in a prima facie case of obviousness, there must be some motivation to combine it with Jacobsen et al. See: MPEP §2143. It is not immediately apparent what motivation there might be to combine the references and the Examiner has not provided any evidence that suggests why it would be proper to combine the cited references. See: MPEP §2143 citing Ex parte Skinner, 2 USPQ 2d 1788 (Bd. Pat. App. & Inter. 1986). Therefore, Applicants respectfully submit that a prima facie case of obviousness has not been properly established and the rejection of claims 76-87 should be withdrawn.

Conclusion

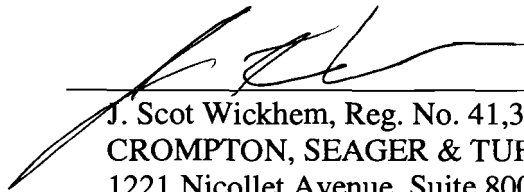
Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

CLARK C. DAVIS et al.

By their attorney,

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J. Scot Wickhem, Reg. No. 41,376
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349